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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/220,910	12/24/1998	THOMAS E. WALSH	2207-6033	5446

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EXAMINER

VU, THONG H

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 07/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/220,910

Applicant(s)

WALSH, THOMAS E.

Examiner

Thong H. Vu

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 42-77 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 42-77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. Claims 1-41 have been cancelled. New claims 42-77 are pending.

Response to Arguments

2. Applicant's arguments, see pages 14-18, filed 5/23/06, with respect to the rejection(s) of claim(s) 1-41 under Krause-Watanabe, Bobo-Fabbio have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Rosenberg-Knowlton.

3. Examiner respectfully traverse the applicant's argument to "un-selected indicator". In common sense, at least the claim invention points out a selected indicator then introduces an unselected indicator. The claims invention merely discloses a document with an un-selected indicator is an indefinite claim language. Examiner considers any file/document has all un-selected indicators. Thus, the claim language is vague, ambiguous and indefinite.

Claim Rejections - 35 USC § 112

4. Claims 42,56,61,65,68 and 69 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 68 is rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. "Unspecified address" is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

"Unspecified address" is not disclosed in specification.

6. Claim 56 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- "a third storage device to store an indicator".

It was unclear that the storage device is a hard disk or the other computer (i.e.: a router, gateway with routing table, Network translation table). An indicator could be IP address, URL, hyperlink and any device connected to Internet has its own address or indicator. It was obvious that any computer connected to network has one address, indicator. Examiner can not determine what applicant intention.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 42-70 are rejected on the ground of nonstatutory double patenting over claims 1-16 of U. S. Patent No. 6,452,610 B1 ('610) since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

('610) 1.A method of displaying graphics in a computer system comprising:	(Application) 65. A method comprising:
receiving at least one <u>set of graphical descriptors</u> , each graphical descriptor corresponding to a graphical image of a streaming video;	processing said prime document to locate an un-selected indicator, said primary document having a <u>list</u> of at least one address;
selecting a subset of said at least one set of graphical descriptors based on at least one indicator indicating whether to display a graphical image corresponding to said graphical descriptor,	
indicating whether to display a first video frame corresponding to a first video frame description, and wherein said indicator is one of a <u>plurality indicators</u> received, each indicator corresponding to one of a <u>plurality of sets</u> of video frame descriptions;	identifying an address of said recipient associated with said located un-selected indicator; and attaching said address of said recipient to said list of said at least one address to encapsulate said address of said recipient within said primary document.
decompressing the video frames corresponding to said selected subset of video frame descriptions displaying the video frames corresponding to said selected subset of video frame descriptions; and dropping compressed video frames corresponding to <u>unselected</u> video frame descriptions.	

It was clearly that the video frame (i.e.: document) contains a plurality of indicators including a selected indicator and unselected indicator which corresponding (i.e.: encapsulated) to the other video frame.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 42-68 are rejected under 35 U.S.C. 102(e) as being anticipated by Rosenberg et al [Rosenberg 5,956,484].

8. As per claim 42, Rosenberg discloses A method comprising:

processing said primary document to locate an un-selected indicator [Rosenberg, a HTML file embed with on ore more IFF file, col 10 lines 9-24; HTML file with a number of components, col 11 lines 12-32, Fig 7B];

identifying a second document associate said located un-selected indicator, and attaching said secondary document to said primary document to encapsulate said

secondary document within primary document [Rosenberg, unselected item or icon, URL, hyperlink or Web component, col 11 lines 33-65; embedded tag having an IFF reference, col 12 lines 40-52].

9. As per claim 43, Rosenberg discloses said unselected indicator includes at least one word, and which said identifying said second document is performed as a function of said at least one word as inherent feature of embedded tag.

10. As per claim 44, Rosenberg discloses said unselected indicator includes a plurality of words, and wherein said identifying said secondary document is performed as a function of said plurality of words within a predetermined proximity of said unselected indicator included in said plurality of words as inherent feature of embedded tag.

11. As per claim 45, Rosenberg discloses associating a predetermined word with at least one of a filename and a location of said secondary document, wherein said primary document includes said predetermined word, and wherein identifying at least one of said Rename and said location of said secondary document is performed as a function of said predetermined word as inherent feature of embedded tag.

12. As per claim 46, Rosenberg discloses said un-selected indicator includes at least one of a plurality of predetermined words, a plurality of predetermined characters; and a plurality of predetermined phrases as inherent feature of embedded tag.

13. As per claim 47, Rosenberg discloses processing said primary document to locate said un-selected indicator is performed using syntactic processing [Rosenberg, a HTML file embed with on ore mote IFF file, col 10 lines 9-24].

14. As per claim 48, Rosenberg discloses said primary document includes an e-mail message or HTML file [Rosenberg, a HTML file embedded with one or more IFF file, col 10 lines 9-24].

15. As per claim 49, Rosenberg discloses sending said e-mail message and said secondary document attached thereto to a recipient via a communications device or HTML file [Rosenberg, a HTML file embedded with one or more IFF file, col 10 lines 9-24].

16. As per claim 50, Rosenberg discloses sending said primary document and said secondary document attached thereto to a printing device as inherent feature of Internet.

17. As per claim 51, Rosenberg discloses sending said primary document and said secondary document attached thereto to a recipient via facsimile as inherent feature of Internet.

18. As per claim 52, Rosenberg discloses said secondary document is attached to said primary document at a first instance, said first instance being determined as a function of user input [Rosenberg, a HTML file embedded with one or more IFF file, col 10 lines 9-24].

19. As per claim 53, Rosenberg discloses at least one additional indicator to said unselected indicator as a function of a user input [Rosenberg, a HTML file embedded with one or more IFF file, col 10 lines 9-24].

20. As per claim 54, Rosenberg discloses said identifying said secondary document comprises using natural language processing techniques as a design choice.

21. As per claim 55, Rosenberg discloses said using natural language processing techniques comprises at least one of using word association processing and using probability matching as inherent feature of Internet.

22. As per claim 56 Rosenberg discloses A document preparation system, comprising:

a first storage device to store said primary document [Rosenberg, client machine, Fig 1];

a second storage device to store a secondary document [Rosenberg, web server, Fig 1];

a third storage device to store an indicator [Rosenberg, other linked resource, col 12 lines 10-12]; and

a processor coupled to said first storage device, said second storage device and said third storage device, said processor to process said primary document to locate an un-selected indicator, identify said second document associated with said located un-selected indicator, and attach said secondary document to said primary document to encapsulate said second document within said primary document [Rosenberg, unselected item or icon, URL, hyperlink or Web component, col 11 lines 33-65; embedded tag having an IFF reference, col 12 lines 40-52].

23. As per claim 57, Rosenberg discloses said secondary document has a filename and a location, wherein said primary document includes at least one word, and wherein said processor determines at least one of said filename and said location of said secondary document as a function of at least one of a user input and said at least one word as inherent feature of name/value pair [Rosenberg, Fig 9].

24. As per claim 58, Rosenberg discloses a predetermined word is associated with it least one of said filename and said location of said secondary document wherein said

primary document includes said predetermined word, and wherein said processor identifies at least one of said filename and said location of said secondary document as a function of said predetermined word [Rosenberg, Fig 9].

25. As per claim 59, Rosenberg discloses said un-selected indicator includes at least one of a plurality of predetermined words, a plurality of predetermined characters, and a plurality of predetermined phrases as inherent feature of embedded tag.

26. As per claim 60, Rosenberg discloses said processor determines if said primary document includes said indicator using syntactic processing as inherent feature of embedded tag.

27. As per claim 61 Rosenberg discloses A document preparation system, comprising:

a storage device; a set of instructions store on the storage device; and a processor to execute said set of instructions to perform a method to identify a secondary document having an un-specified location relative to a primary document said method comprising:

processing said primary document to locate an un-selected indicator; identifying a secondary document associated with said located un-selected indicator; and attaching said secondary document to said primary document to encapsulate said secondary document within said primary document [Rosenberg, unselected item or

icon, URL, hyperlink or Web component, col 11 lines 33-65; embedded tag having an IFF reference, col 12 lines 40-52].

28. As per claim 62, Rosenberg discloses said secondary document has a filename and a location, wherein said primary document includes at least one word, and wherein said processor determines at least one of said filename and said location of said secondary document as a function of at least one of a user input and said at least one word [Rosenberg, name/value pair Fig 9].

29. As per claim 63, Rosenberg discloses said un-selected indicator includes at least one of a plurality of predetermined words, a plurality of predetermined characters, and a plurality of predetermined phrases as inherent feature of embedded tag.

30. As per claim 64, Rosenberg discloses said processor determines if said primary document includes said indicator using syntactic processing as inherent feature of embedded tag.

31. As per claim 65 Rosenberg discloses A method comprising:
processing said primary document to locate un-selected indicator said primary document having a list of at least one address; identifying an address of said recipient associated with said located un-selected indicator; and attaching said address of said recipient to said list of said at least one address to encapsulate said address of said

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recipient within said primary document [Rosenberg, unselected item or icon, URL, hyperlink or Web component, col 11 lines 33-65; embedded tag having an IFF reference, col 12 lines 40-52].

32. As per claim 66, Rosenberg discloses said un-selected indicator includes at least one of a plurality of predetermined words a plurality of predetermined characters, and a plurality of predetermined phrases [Rosenberg, embedded tag having an IFF reference, col 12 lines 40-52].

33. As per claim 67 Rosenberg discloses said primary document includes at least one address corresponding to at least one recipient to receive said primary document further comprising attaching said address of said recipient to said list of said at least one address [Rosenberg, a set of generic features [Rosenberg, col 12 lines 53-65].

34. Claim 68 contains the identical limitation set forth in claim 42. Therefore claim 68 is rejected for the same rationale set forth in claim 42.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 69-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenberg et al [Rosenberg 5,956,484] in view of Knowlton et al [Knowlton 5,973,692].

35. As per claim 69 Rosenberg discloses A method comprising;

processing said primary document to locate an un-selected indicator; identifying a secondary document associated with said located un-selected indicator [Rosenberg, unselected item or icon, URL, hyperlink or Web component, col 11 lines 33-65; embedded tag having an IFF reference, col 12 lines 40-52];

However Rosenberg does not explicitly detail automatically encapsulating said secondary document within said primary document upon identifying said secondary document.

In same endeavor, Knowlton discloses a system for the capture and indexing of graphical representation of files information sources using Visual Links Automatic capture engine [Knowlton, col 10 lines 48-62].

Therefore it would have been obvious to an ordinary skill in the art at the time the invention was made to incorporate the Visual Links Automatic Capture Engine as taught by Knowlton into the Rosenberg's apparatus in order to utilize the embedded tag. Doing so would provide a visual link without increasing the size of the file [Knowlton, col 2 lines 24-30].

36. Claims 70-77 contain the identical limitation set forth in claims 42-55. Therefore claims 70-77 are rejected for the same rationale set forth in claims 42-55.

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THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner *Thong Vu*, whose telephone number is (571)-272-3904. The examiner can normally be reached on Monday-Thursday from 6:00AM- 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Andrew Caldwell*, can be reached at (571) 272-3868. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval IPAIRI system. Status information for published applications may be obtained from either Private PMR or Public PMR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thong Vu
Primary Examiner
Art Unit 2142

A handwritten signature in black ink, appearing to read 'Thong Vu', with a horizontal line underneath.